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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OPPENHEIMER WOLFF & DONNELLY, LLP (ACCENTURE)
PLAZA VII, SUITE 3300
45 SOUTH SEVENTH STREET
MINNEAPOLIS, MN 55402-1609

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,735

Applicant(s)

SLOAN ET AL.

Examiner

Yogesh C Garg

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-15,18-21 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-15,18-21 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>16</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/26/2004 has been entered.

Response to Amendment

2. Amendment F, paper # 18, received on 01/26/2004 is acknowledged and entered. The received amendment is incorrect for following reasons: Following informalities/errors have been observed in the claims:

Claim 1 is amended and correctly numbered. However, the term, "for the primary purpose" in the preamble is added newly. The applicant is requested to either delete this term to synchronize with the preamble of claim 1 of the earlier amendment E or present it as an amended preamble.

Claim 2, as presented in this amendment F, is a new claim, which was not presented in the earlier amendment E. Hence, this claim is not treated further on merits. The applicant must either cancel this claim or present it as a new claim with a different number.

Claim 3, as presented in this amendment F, is to be correctly numbered as 2 to synchronize with the claim 2 of the earlier amendment E. In addition, the term, "The method of

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claim 2 further comprising" to be changed to -- The method of claim 1 further comprising ---.

Claim 2 is amended.

Similarly, claims 4,5 and 6 need to be correctly numbered as 3,4, and 5 and also the term , " The method of claim 2 further comprising" to be changed to -- The method of claim 1 further comprising --- to synchronize with the claims 4,5 and 6 of the earlier amendment E. Claims 3,4, and 5 are amended.

Claims 7 and 8 presented in this amendment F need to be correctly numbered as 6 and 7. Therefore, the canceled claims will be 6 and 7 instead of 7 and 8 as presented in this amendment F.

Claim 8 of the earlier amendment E is not presented. Therefore, as best understood by the examiner claim 8 is considered canceled.

Claim 9 is amended and correctly numbered.

Claim 10 (original) is correctly numbered. However, the term, "said wide area network" to be changed to – the Internet --- to synchronize with the claim 10 of the earlier amendment E.

Claims 11 and 12, as presented in this amendment F, are new claims, which were not presented in the earlier amendment E. Hence, these claims are not treated further on merits. The applicant must either cancel these claims or present them as new claims with different numbers.

Claims 13, 14, 15, 16, 17 and 18 (original) presented in this amendment F need to be correctly numbered as 11, 12, 13, 14, 15, and 16 to synchronize with the claims 11, 12, 13, 14, 15, and 16 of the earlier amendment E. Therefore the canceled claims will be 14 and 15 instead 16 and 17 as presented in this amendment F.

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Claims 19, and 20 presented in this amendment F need to be correctly numbered as 17 and 18 to synchronize with the claims 17 and 18 of the earlier amendment E. Claims 17 and 18 are amended.

Claims 19 and 20 of the earlier amendment E are not presented. Therefore, as best understood by the examiner claims 19 and 20 are considered canceled.

Claim 21 is amended and correctly numbered.

Claims 22 and 23 are canceled and are correctly numbered.

Claim 24 (original) and is correctly numbered.

Note: This is for the second time such informalities and errors have been observed (Earlier amendment D included such informalities and errors, as well, and was corrected in the following Amendment E). Applicant is requested to avoid repeating such errors.

The above informalities/errors must be corrected.

In view of the above informalities/errors, and to synchronize the numbering with the claims of the earlier amendment E, the summary is as following: Claims 1-5, 9, 17-18 and 21 are amended. Claims 6-8, 14-15, 19-20, and 22-23 are canceled. Claims 10-13, 16, and 24 are maintained as original. Currently claims 1-5, 9-13, 16, 17-18, 21 and 24 are pending.

Response to Arguments

3. Applicant's arguments (see amendment F on pages 7-10) with respect to claims 1-5, 9-13, 16, 17-18, 21 and 24 filed on 01/26/2004 have been considered but are not persuasive for the following reasons: The arguments presented on pages 7-10 are substantially repeat of the earlier arguments filed in amendment E, which were replied to in the previous office action except for the following new issues:

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(i) The arguments concerning the newly added limitations to independent claims 1, 9, and 17, "providing financial modeling in a web-based environment" and "such that user is assisted in achieving financial goals and optimizing long-term goals" are moot in view of the new ground(s) of rejection i.e. reference Ray et al. (US Patent 6,018,722), hereinafter, referred to as Ray.

(ii) The newly added limitation in claims 1, 9, and 17, "establishing communication between said user and said live advisor transmitting streaming live video or still video clips upon the user's selection" has already been analyzed and rejected in the canceled claims 6, 7, 14, 15, 22, 23 in the previous office action.

(iii) The applicant argues, "The live coaching is via a coach and not a financial advisor; meaning the coach of the present invention is not licensed by the SEC as required for a financial advisor" (see amendment F, page 7). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., meaning the coach of the present invention is not licensed by the SEC) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(iv) The applicant argues that the Press release does not disclose, similar to the applicant's invention, receiving automated and live financial coaching via transmitting streaming live video or still video clips over the Internet (see amendment F, page 8). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the present case, the applicant has argued against the

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reference, "Press release" individually and have not included the combination of references of Weblin in view of Schilleru-Key (US Patent 6,388,688) considered in the previous action to analyze the recited limitation, "receiving automated and live financial coaching via transmitting streaming live video or still video clips over the Internet "as being unpatentable under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 9-13, 16, 17-18, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Press release, "Kana and Weblin Team to Provide Industry's Most Comprehensive Online Customer Interaction Solution "; Business Wire; New York; Apr 20, 1999, pages 1-3, extracted on Internet from <http://proquest.umi.com> on 03/04/2003, hereinafter, referred to as Weblin in view of Ray et al. (US Patent 6,018,722), hereinafter, referred to as Ray and further in view of Schilleru-Key (US Patent 6,388,688).

4.1. With regards to method claims 1-5, Weblin teaches a method for providing a communication medium over a wide area network, including the Internet, for the primary purpose of providing a financial modeling and counseling system comprising:

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providing automated financial coaching in a web-based environment; displaying to a user a plurality of communication options with a live advisor in said web page environment; and enabling a communication medium between said user and a live advisor based on the user selected communication option whereby said live advisor may provide live financial coaching in a collaborative medium for sharing data between said user and a live advisor upon the selection of a communication option from electronic mail, online chat, voice or talk with stand alone telephone options (The applicant's claims are directed to establishing a variety of automated communication options, in a web-based environment, between user and live advisor to provide financial coaching and Weblines supported by Press release, "Weblines Communications' Products Selected By Trimark Investments To Increase Service On financial Adviser Web Site"; Business Wire; March 22, 1999, extracted on Internet from Dialog database on 02/26/2003 and combined with Schileru-Key discloses the recited limitations (see at least Weblines, page 2, under the head, "About the WebLine Solution The Weblines Collaboration Server enables company representatives to share information with customers over the Web....while conducting a voice conversation or text chat....integrating multimedia types-including PSTN calls, interactive Web sessions, e-mail, text chat and voice-over-IP calls----", and head, "About WebLine Communications.....Customers includefinancial services....such as Putnam Investments, Trimark Investment management Inc....."). As per the disclosure in Weblines that Trimark Investment management uses Weblines software a detail enabling disclosure is presented in the Press release, wherein it is explicitly shown/suggested that Trimark, while using Weblines software provides financial coaching (see press release, page 1, "....Trimark is committed to providing leading-edge customer service in the financial services industry....To enable this new real-time service option, Trimark has implemented Weblines Communications' Collaboration Server..... The Weblines Collaboration Server enables Trimark representatives to

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share information with financial advisers over the Web-including Web pages, forms or applications.....allowing Trimark representatives to respond to Web requests and telephone calls from within a common queue on their desktops and provide a consistent, unified face to their customers to their customers.....visitors to Trimarks' Financial Advisers Web site can click on a "Call Me Now" button.....they can co-navigate the Web, securely share electronic documents....").

Weblines, as applied to claim 1-5, does show providing financial modeling and coaching such that said user is assisted in achieving financial goals and optimizing long-term goals. However, in the field of same endeavor, Ray suggests providing financial modeling and coaching such that said user is assisted in achieving financial goals and optimizing long-term goals (see at least abstract, "*A computer implemented expert securities portfolio investment management system...operates as Registered Investment Advisor.....system automatically defines personal customer objectives, designs portfolios.....researchesselects.....evaluates specific securities....*", col.9, lines 29-65, "*..... displaying investment recommendations, account information.....*", col. 4, line 62-col.5, line 48, "*The first step is to determine the personal asset allocation model 115 which is derived from a look up table according to customer answers to a questionnaireThe system compares these variables to answers on a look up table to determine which level of risk is appropriate to the investor.....This approach permits the customer an extensive number of possible portfolio designs. This breadth of diversity permits unusual depth of precision.....is the beginning of individualized management process... present invention to operate as a RIA.....*" Note: In Ray, defining personal customer objectives, designing portfolios, displaying recommendations, determining asset allocation as per customer's responses to a questionnaire and preferences for risk levels

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correspond to providing financial modeling and coaching such that said user is assisted in achieving financial goals and optimizing long-term goals . RIA dynamically analyzes the user's intentions by doing economic analysis, fundamental analysis, technical analysis and risk/return analysis (see at least col.2, lines 19-39 and col.5, line 59-col.8, line 62) and this process also corresponds to optimizing the customer's long-term goals.).

In view of Ray, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Weblines, as applied to claims 1-5, to incorporate the feature of providing financial modeling and coaching such that said user is assisted in achieving financial goals and optimizing long-term goals. Doing so helps the consumers in minimizing risks and creating efficient portfolios for their future, as explicitly disclosed by Ray (see at least col.1, line 64-col.2, line 4).

Weblines in view of Ray, as applied to claims 1-5, does not show establishing communication between said user and said live advisor transmitting streaming live video or still video clips upon the user's selection. However, in the same field of real interactive navigation via a network, Schileru-Key teaches the use of video clips and streaming live video (see at least col.4, lines 55-65, "*....In one embodiment, the sequence is video clip.....in some embodiments, the image sequences may be shown using streaming video*") to provide an interactive navigation and exploration of real and virtual environments and to present auxiliary information related to points of interest (see at least col.1, line 55-col.2, line 15).

In view of Schileru-Key, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Weblines in view of Ray as applied to claims 1-5 to incorporate the features of Schileru-Key of using video clips and streaming videos because to

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assist the users in interactive navigation of information being presented to them as explicitly disclosed in Schileru-Key (see at least col.1, line 55-col.2, line 15).

4.2. With regards to system claims 9-13, and 16, and a computer program readable medium claims 17-18, 21, and 24, their limitations correspond to the limitations of method claims 1-5, and are therefore analyzed and rejected using the same rationale under 35 U.S.C. 103(a) as being unpatentable over Weblin in view of Ray and further in view of Schileru-Key.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 5,784,696 to Meinikoff discloses an automated computerized system and a method for providing financial coaching and modeling such that said user is assisted in achieving financial goals and optimizing long-term goals (see at least col.5, line 25-col.6, line 3, col.10, line 10-col.18, line 27).

(ii) US Patent 5,978,778 to O'Shaughnessy discloses an invention related to an automated computerized system and a method for providing financial coaching and modeling such that said user is assisted in achieving financial goals and optimizing long-term goals by optimum selection of stocks for his portfolio in commensurate with his preference for risk (see at least col.12, line 1-col.15, line 5).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Examiner
Art Unit 3625

YCG
February 28, 2004